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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SCHMEISER, OLSEN & WATTS
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EXAMINER

CORRIELUS, JEAN M

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,077

Applicant(s)

BERRY ET AL.

Examiner

Jean M. Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/08/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the Applicant's remark filed on October 13, 2005, in which claims 1-54 are presented for further examination.

Response to Arguments

2. Applicant's arguments with respect to claims 1-54 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically, as directed to an abstract idea.

Claims 1-54 in view of **MPEP section 2106 IV.B.2. (b)** define non-statutory processes because they merely manipulate an abstract idea without a claimed limitation to a practical application. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Data structure not claimed as embodied in computer-readable media is descriptive material per SE and is not statutory because they are neither physical nor statutory processes. Structural and functional interrelationship with a general-purpose computer for permitting claimed functions to be realized are not provided in

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the claims. In contrast, a claimed system should define structural and functional interrelationships between data structures or functional parts and a computer system which permit the data functions to be realized, and is statutory. Thus, the claimed are rejected as being non-statutory. Additionally, the invention, as claimed, is directed to the manipulation of an abstract idea with no practical application in the technology arts.

The Supreme Court has repeatedly held that abstractions are not patentable. "An idea of itself is not patentable". Rubber-Tip Pencil Co. V. Howard, 20 wall. 498, 07. Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basis tolls of scientific and technological work Gottschalk V. Benson, 175 USPQ 673, 675 (S Ct 1972). It is a common place that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter Parker V. Flook, 197 USPQ 193, 201 (S Ct 1978). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Wamerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600,1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why

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the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Claims 1, 3, 17, 22, 25, 28, 30, 44 and 3 represent an abstract idea, which do not provide a practical application in the technological arts. There is no post computer process activity is found in the technological arts. The method for determining whether to store a contract dataset or a first portion thereof in a relational database is not a physical transformation. Thus, no physical transformation is performed, no practical application is found in the claims. The claims do not produce a useful concrete and tangible result in the technology art. Also, the claims do not appear to correspond to a specific machine or manufacture disclosed within the specification and thus encompass any product of the class configured in any manner to perform the underlying process, and are thus rejected as being directed. Claims 1 and 3 are not **tangibly embodied** in a manner so as to *be executable* as the only hardware is in an intended use statement. Therefore, claims 1 and 3 are directed to an abstract idea that is not tied to a technological art, environment

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or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

The dependent claims 2, 4, 18-21, 23-24, 26-27, 29, 31-32 and 45-48 are rejected for fully incorporating the errors of their respective base claims by dependency.

Claims 5, 13, 32, 40, 49 and 52 are directed to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. The claims do not provide a practical application in the technological arts nor a post computer process activity is found in the technological arts to manage the contract data. The claims are not **tangibly embodied** in a manner so as to be executable as the only hardware is in an intended use statement.

The dependent claims 6-12, 14-16, 33-39, 41-43, 50-51 and 53-54 are rejected for fully incorporating the errors of their respective base claims by dependency.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. The body of claims 1, 3, 5, 13, 17, 22, 25, 28, 30, 32, 40, 44, 49 and 52 do not appear to actually support the preamble by including a step or steps which accomplish that act. Claims 5, 13, 32 recite "said N at least 1" line 6, 4, 6 respectively. Claim 22, 25, 49 and 52 recite "said I at least 1" line 3. Claim 40 recite "said M at least 1", line 5. It is not clear as what the applicant tries to accomplish. Clarification of such language is required. Applicant is also advised to define the variables (J, I, K, M, N and V) in the claimed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set

Claim Objections

7. Claims 1-55 are objected to because they include reference acronyms (DES, SAP and PCMS), which are not enclosed within parentheses. Applicant is advised that acronyms are not acceptable in the claimed language, for example.

Applicant is reminded that reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-4, 17-21, 28-31 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Yin et al (hereinafter “Yin”) US patent application Publication No. 2002/0091539.

As to claim 1, Yin discloses the claimed “receiving a contract dataset by a decentralized execution system from a procurement contract management system” ([0011]; [0023]-[0025]; [0076]-[0085].); and “passing the contract dataset through a software filter ([0083]-[0085]) that determines whether to store the contract dataset or a first portion thereof in a relational database of the DES, said relational database including contract datasets, vendor datasets, and purchase item datasets” ([0097]-[0103]).

As to claim 2, Yin discloses the claimed “wherein the software filter further determines whether to store the contract dataset or a second portion thereof in a special database of the decentralized execution system” ([0011]; [0023]-[0025]; [0076]-[0085]).

As to claim 3, Yin discloses the claimed “receiving a contract dataset by a first SAP contract management system from a second SAP contract management system” ([0011]; [0023]-[0025]; [0076]-[0085]); and “passing the contract dataset through a software filter that determines

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whether to store the contract dataset or a second portion thereof in a non-SAP database of the first SAP contract management system” ([0097]-[0103]).

As to claim 4, Yin discloses the claimed “wherein the software filter further determines whether to store the contract dataset or a second portion thereof in a special database of the decentralized execution system” ([0011]; [0023]-[0025]; [0076]-[0085]).

As to claim 17, Yin discloses the claimed “having an execution document at a decentralized execution system of a procurement contract management system, said execution document being derived from a contract dataset in the DES, said execution document having an existing attribute value for a purchase item in the contract dataset ([0011]; [0023]-[0025]; [0076]-[0085], [0101]); “receiving notice at the DES from PCMS of a new attribute value that is to replace the existing item in the contract dataset” ([0020]-[0021][0025]); and “replacing the existing attribute value with the new attribute in the execution document” ([0025], [0074]), [0098]-[0099]; [0136]).

As to claim 18, Yin discloses the claimed “said existing attribute value for the purchase item being a first price of the purchase item, said new attribute value for the purchase item being a second price of the purchase item” ([0098]-[0101], [0107]-[0109], [0142]—[0144]).

As to claim 19, Yin discloses the claimed “said execution document being a purchase order” ([0101]-[0104], [0111]-[0122]).

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As to claim 20, Yin discloses the claimed “said execution document being a schedule agreement whose new attribute value for the purchase item is effective upon receipt of the purchase item by a DES buyer keyed of the purchase item” ([0135]-[0137]).

As to claim 21, Yin discloses the claimed “said PCMS and said DES each being a SAP system” ([0011]-[0014]).

As to claims 28-29, the limitations of claims 28-29 have been noted in the rejection of claims 1-2 above. They are, therefore, rejected under the same rationale.

As to claims 30-31, the limitations of claims 30-31 have been noted in the rejection of claims 3-4 above. They are, therefore, rejected under the same rationale.

As to claim 55, Yin discloses the claimed “DES software selected from a group consisting of DES FILTER software, DES Update software, DES Archive software, and combinations thereof” ([0016], [0085]; fig.3; [0099]).

Allowable Subject Matter

10. Claims 5-16, 22-27, 32-43 and 49-54 are allowable over the prior art made of record.

11. The following is a statement of reasons for the indication of allowable subject matter:

Upon searching a variety of databases, the examiner respectfully submits that –determining which, if any, of the N purchase items identified in the contract data group Dg match a purchase

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item in the purchase item datasets and determining a total number K of such purchase items in D_g that do not so match a purchase item in the purchase item datasets, said K satisfying $0 < K < N$; and if $K < N$ then

If the contract data group D_g is the contract dataset then determining whether the vendor V matches a vendor in the vendor datasets and if the vendor V so matches a vendor in the vendor datasets then adding a subset of D_g to the relational database, said subset of D_g excluding the K purchase item from D_g else

If the contract data group D_g is the contract delta dataset and D_g is keyed to a first contract dataset in the relational database then adding to the first contract dataset in relational database a remaining $N-K$ purchase items of D_g .-- in claims 5, 13, 25, 32, 40, 49 and 52 in conjunction with all other limitations of the dependent claims, are not taught nor suggested by the prior art of record. Therefore, the pending claims 5-16, 22-27, 32-43 and 49-54 are hereby allowed.

As allowable subject matter has been indicated, applicants are encouraged to submit formal drawings in response to this Office action. The early submission of drawings will permit the office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

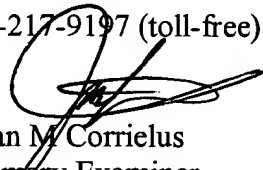
Any comments considered necessary by applicants must be submitted no later than the payment of the issues fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "comments on statement of reasons for allowance".

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean M. Corrielus
Primary Examiner
Art Unit 2162

May 11, 2006